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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/555,040

11/21/2005

Susanne Emig

05-549-CIP

2756

34704 7590 10/01/2008

BACHMAN & LAPOINTE, P.C.

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SUITE 1201

NEW HAVEN, CT 06510

EXAMINER

HELM, CARALYNNE E

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

10/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/555,040	<b>Applicant(s)</b> EMIG ET AL.	
	<b>Examiner</b> CARALYNNE HELM	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 44-92 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 44-92 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Election/Restrictions***

#### ***Restriction***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 44-91, drawn to a preparation in the form of an emulsion.

Group II, claim 92, drawn to a method of making a preparation in the form of an emulsion.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: their common technical feature is not novel. The common technical feature of each group is an emulsion with an emulsifier, and solids phase as well as an outer lipophilic phase containing a polyvalent ester and volatile silicone, and an inner phase containing an aqueous medium. Chopra et al. (US PGPub No. 2002/0192172) teaches a water-in-oil emulsion with an external phase comprising a volatile silicone and emollient where glyceryl esters and behenyl behenate are specifically named as particular envisioned varieties (see paragraphs 16, 19, 21, 41-42, and 45). The emulsion is envisioned to contain water in the inner phase as well as solids (fillers) and an emulsifier (see

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paragraphs 23-24, 70, 135, and 154 lines 33-35). Thus since, the common technical feature was known in the art, this technical feature cannot be deemed as special.

### ***Election of Species***

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Should Group I be elected, then the following election of species applies:

Each species has the same base constituents, but are distinguished from one another by the presence of a/an additional ingredient(s) or distinct claimed form. The base constituents in each species is an emulsion with an emulsifier and solids phase as well as an outer lipophilic phase containing a polyvalent ester and volatile silicone, and an inner phase containing an aqueous medium. Applicant is required to select one of A, B, C, or D.

Species A: emulsion also comprising ingredients which can be derived from plants and/or which are mineral and/or synthetic and in that respect is completely free from substances which derive from animals (claim 52).

Species B: emulsion also comprising a wax (claims 53-57)

Species C: emulsion also comprising an agent for keeping the preparation moist and/or a stabilization agent (claims 67-75)

Species D: emulsion where preparation is a workable water-in-silicone paste (claim 91)

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For the elected species applicant is also required to make a selection for each of the following:

- a particular polyvalent ester or ester mixture (such that all variable constituent groups and atoms are distinctly defined)
- a particular volatile silicone or silicone mixture
- particular emulsifier(s)
- particular solid(s) in solids phase

Should Group II be elected, then applicant must make a selection for each of the following:

- a particular polyvalent ester or ester mixture (such that all variable constituent groups and atoms are distinctly defined)
- a particular volatile silicone or silicone mixture
- particular emulsifier(s)
- particular solid(s) in solids phase

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the common technical feature is not special. The common technical feature is the same as that described above (see **Restriction** section). This feature was known in the art at the time of the invention since it was taught by Chopra et al. Therefore the common technical feature cannot be deemed as special.

Applicant is required, in reply to this action, to elect a single invention and species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also *identify the claims readable on the elected species, including any claims subsequently added*. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

The election of an invention or species may be made with or without traverse (37 CFR 1.143). To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARALYNNE HELM whose telephone number is (571)270-3506. The examiner can normally be reached on Monday through Thursday 8-5 (EDT).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Caralynne Helm/  
Examiner, Art Unit 1615

/MP WOODWARD/  
Supervisory Patent Examiner, Art Unit 1615